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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,140	07/20/2000	Takahito Kumazaki	000866	3486

23850 7590 06/17/2003

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EXAMINER

TRAN, MINH LOAN

ART UNIT	PAPER NUMBER
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2826

DATE MAILED: 06/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/621,140

Applicant(s)

KUMAZAKI ET AL.

Examiner

Minhloan T. Tran

Art Unit

2826

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 04 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 04/04/2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 3 stand rejected under 35 U.S.C. 102(b) as being anticipated by Koepf (4,173,001) as the reasons set forth in the Office Action paper no.6.

Koepf discloses a laser device 10 including an amplifying section 12 in which a laser medium is amplified to oscillate laser light, comprising a reflector 44 having a non-reflecting portion 46 which is provided on approximately center portion and transmits the laser light 18 at high transmissivity and a total reflecting portion 43 which is provided outside a perimeter of the non-reflecting portion 46 and reflects the laser light 14 at high reflectivity; wherein the reflector 44 separates part of the laser light 18 oscillated in the amplifying section 12 and shapes a beam form of the laser light 18 into a desired form to output the same. Note figures 1, 3, 4 of Koepf.

It is inherent that the reflector 44 of Koepp functions as a prism because it performs the same function as the prism of the claimed invention, such as it has a non-reflecting portion 46 which is provided on approximately center portion for transmitting the laser light 18 at high transmissivity and a total reflecting portion 43 which is provided outside a perimeter of the non-reflecting portion 46 for reflecting the laser light 14 at high reflectivity, so that the reflector 44 shapes a beam form of the laser light 18 into a desired form to output the same through the non-reflecting portion 46. Note lines 51-68 in column 5 and lines 1-4 in column 6 of Koepp.

Allowable Subject Matter

3. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 4 is allowable over the references of record because none of these references disclose or can be combined to yield the claimed invention such as a front mirror that has a partial reflecting portion which is provided on approximately a center portion for partially reflecting the laser light and a total reflecting portion which is provided outside a perimeter of the partial reflecting portion for reflecting the laser light at high reflectivity.

Response to Arguments

4. Applicant's arguments filed 04/04/2003 have been fully considered but they are not persuasive.

It is argued, at page 10 of the remarks, that "Koeopf does not describe a prism having the non-reflective and total reflecting portions as defined in present claim 3." However, figures 3 and 4, lines 51-68 in column 5 and lines 1-4 in column 6 of Koeopf do disclose the reflector 44 having a non-reflecting portion 46 which is provided on approximately center portion for transmitting the laser light 18 at high transmissivity and a total reflecting portion 43 which is provided outside a perimeter of the non-reflecting portion 46 for reflecting the laser light 14 at high reflectivity, so that the reflector 44 shapes a beam form of the laser light 18 into a desired form to output the same through the non-reflecting portion 46. It is inherent that the reflector 44 of Koeopf functions as a prism because it performs the same function as the prism of the claimed invention.

In response to applicant's argument that the reflector 44 of Koeopf does not functions as a prism, a recitation of the intended use of the claimed invention must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

5. This application contains claims 1,2,5 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minhloan T. Tran whose telephone number is (703) 308-4919. The examiner can normally be reached on Monday-Friday 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (703) 308-6601. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

06/2003
mlt


Minhloan T. Tran
Primary Examiner
Art Unit 2826